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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/491,919	01/27/2000	Dale Burns		9242

7590 10/07/2004

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[REDACTED] EXAMINER

DADA, BEEMNET W

ART UNIT	PAPER NUMBER
	2135

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/491,919	BURNS ET AL. <i>[Signature]</i>
	<b>Examiner</b>	<b>Art Unit</b>
	Beemnet W Dada	2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 May 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-15 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1, 3, 4, 6-11 and 13 have been amended on an amendment filed on 5/24/2004.  
Claims 1-15 have been examined.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1 rejected under 35 U.S.C. 103(a) as being unpatentable over Council (US Patent No. 6192114 A) in view of Ji et al. (hereinafter Ji) (US Patent No. 5,889,943).

4. As per claim 1, the limitation of an email screening system is disclosed by Council, Column 3, lines 22-25. The limitation of a sender and a recipient connected to a network is disclosed in column 3, lines 14-19 and Figure 1, and the limitation that the email screening server is also connected to the same network screening email of the recipient is disclosed in column 3, lines 19-24, lines 39-40. The limitation that the email screening server that the email will be forwarded to the recipient for fee is disclosed in column 1, lines 30-33, Figure 2. Council is silent on computer instructions for screening of email for virus. Ji teaches a client computer (i.e., sender or recipient) having application programs including routines for polling and scanning

Art Unit: 2135

email messages to determine if they contain viruses column 15, lines 45-67, column 16, lines 1-7 and figures 11a-d. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to add a software instructions for virus scanning as per teachings of Ji into the regular scanning for email provided by council system. One of ordinary skill in the art at the time the invention was made would have been motivated to add virus scanning to the regular scanning of email provided by council system, as a means to provide protection to the user from viruses which can be easily scanned at the time of receipt. Claim 1 is rejected.

5. Claims 2-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Council and Ji as applied to claim 1 above, and further in view of Hardy et. al (hereinafter Hardy) (US Patent No. 6073242 A).

6. As per claim 2, with regards to the limitation that a password is used as a means of discerning authorized mail to the user Council is silent. Council teaches the use of an authorization list. Hardy teaches the use of passwords as a means of authorization (Column 9, 15-17). One of ordinary skill in the art at the time the invention was made would have been motivated to use a password system as opposed to an authorization list because such list are difficult to keep updated. Claim 2 is rejected.

7. As per claim 3, the screener holding email without a password. It is inherent in the Council/JI system that since if the sending part is not authorized to send electronic mail to the recipient then the sending party is asked to provide a fee for delivery to the recipient (Column 1,

lines 28-33). Thus in the Council /JI/Hardy system the email would have to be held to determine if the sender is welling to pay the fee. Claim 3 is rejected.

8. As per claim 4, alerting the recipient that an email message is being held by the screening computer which is without password authorization is disclosed by Council. Council any or all of the fee may be paid by the receiving party, which implies that the receiving party must be alerted to authorized mail in order to be given a chance to pay the fee. Claim 4 is rejected.

9. As per claim 5, the limitation that the email screening system further charges the sender a fee to forward email message that is not password authorized to the recipient is disclosed by Council/Ji combination Column 1, lines 30-33. Claim 5 is rejected.

10. As per claim 6, the limitation of a method for screening email, which screens the email for viruses and forwards to recipient if password authorized but holds email if not password authorized is disclosed by the Council/Ji/Hardy combination. In particular Council describes the email scanner with authorization list Column 1, lines 29-33 and Column 3, lines 15-40, Hardy modifies this to allow password authorization Column 9, lines 15-18 and JI provides software for scanning for Viruses column 15, lines 45-67, column 16, lines 1-7. Motivation to combine Council and Hardy is that authorization list are too difficult to keep updated, motivation to modify by Ji is that the chief cause of virus attacks is through email attachments and thus the email scanner could also provide the recipient a second service, that is scanning for viruses. Claim 6 is rejected.

Art Unit: 2135

11. As per claim 7, the limitation of notifying the sender and recipient was addressed in claim 4 and charging the sender fees see Figure 2 of Council. Claim 7 is rejected.

12. As per claim 8, the limitation of providing the recipient the option of receiving email without authorization is not disclosed by the Council/Hardy/Ji but such a option would certainly be one that would be obvious to one of ordinary skill in the art at the time of the invention because if the recipient is out of town for an extended time, they might not wish to miss unexpected mail. Claim 8 is rejected.

13. As per claim 9, the limitation of sharing the fee with the recipient is disclosed by Council, Column 3, lines 54-56. Claim 9 is rejected.

14. As per claim 10, the limitation of re-routing email to be scanned for viruses (See Ji, column 15, lines 45-67, column 16, lines 1-7) and notifying sender that email will be sent to recipient for a fee (Council Figure 2) and sending the email has been paid and sharing the fee (Column 3, lines 54-55) with the recipient is disclosed by Council and Ji. Claim 10 is rejected.

15. As per claim 11, the limitation of virus screening of email (Ji, column 15, lines 45-67, column 16, lines 1-7), setting up authorization within the scanning system for holding mail that was no authorized and forwarding authorized email to recipient (Council, Column 1, lines 2832; Column 3, lines 15-30), and finally setting up password authorization for the system (Hardy, Column 9, lines 15-17). Claim 11 rejected.

Art Unit: 2135

16. As per claim 12, the method of automatically forwarding password authorized email to recipient (Column Figure 2, Hardy Column9, lines 15-17). Claim 12 rejected.

17. As per claim 13, the limitation of notifying sender that email is not password authorized and charging a fee to sender for delivery is disclosed in Council Figure 2, and Hardy (Column 9, lines 15-17). Claim 13 is rejected.

18. As per claim 14, the limitation of sharing fee with recipient (that is a percentage to the recipient) Column 4, 28-30. Claim 14 is rejected.

19. As per claim 15, the limitation of providing a recipient with option to pay for screening and sending email is disclosed by Council column 3, lines 54-55. Claim 15 is rejected.

### ***Response to Arguments***

20. Applicant's arguments with respect to claim 1-14 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO form 892.

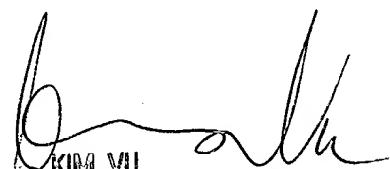
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beemnet W Dada whose telephone number is (703) 305-8895. The examiner can normally be reached on Monday - Friday (8:30 am - 6:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y Vu can be reached on (703) 305-4393. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Beemnet Dada

September 30, 2004



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